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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,731	04/16/2001	Keiko Yamamoto	SAEGU77.001A	6000

20995 7590 01/15/2003

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EXAMINER

PRATT, HELEN F

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/807,731

Applicant(s)

YAMAMOTO ET AL.

Examiner

Helen F. Pratt

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4-16-01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-21 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 15 are indefinite in being incomplete. The claims are incomplete in that they fail to present any process steps.

Specification

The use of the trademark COMITROL in claim 17 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-8, 10-14, 16-17, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshio et al. (60-058055) or Takaaki et al. (01-206965), or Kunihiko (05-328934) or Lewis et al. (5,858,446) and Greff (5,750,181).

Toshio et al. disclose a composition made up of grated radish, which has been treated with an acid solution (abstract)(claims 1 and 4). Takaaki discloses a vegetable composition, which is pasty in which the vegetables have been treated with a salt or vinegar and then ground (abstract) (Claims 1 and 3). Kunihiko discloses a composition containing grated yam (a vegetable) and vinegar with a pH of from 2-5 (abstract). No heat is seen in any of the above references. Lewis et al. disclose a composition containing comminuted herbs (vegetables) and an organic acid (claim 1 and 18, 19) such as erythroic acid or ascorbic acid with a particle size of 5x5mm (col. 4, lines 22-25, col. 6, lines 10-20). Greff discloses a composition containing ground onions and acids at a pH of 4 (abstract and col. 2, lines 20-25, and col. 4, lines 5-20. Claims 1 and 3, 4 differ from the references in the use of a particular pH and in that the composition does not have catalase activity. However, acids, are known to have low pH's and the problem of preventing discoloration is overcome by using acids as in the reference to Toshio et al. Nothing is seen at this time that the pH required to prevent discoloration would not have been within the claimed range. Also, Kunihiko discloses the claimed pH range (abstract). Since Kunihiko discloses the claimed pH range and nothing is seen that the other two references do not have the claimed pH, it is seen that there is no catalase activity as the composition is the same. Therefore, it would have been obvious

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to make a composition containing a vegetable puree and acid at within a claimed range, which has no catalase activity.

Claim 2 further requires a process step of grinding and the addition of acid.

Claim 2 is also a product by process claim. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796. In addition, the above references do show the claimed process limitations. Therefore, it would have been obvious to grind and apply an acid.

Claim 5 further requires freezing the puree. Lewis et al. disclose freezing the product (col. 5, lines 40-45). Therefore, it would have been obvious to freeze the treated product.

The limitations of claims 6 and 7 have been discussed above and are obvious for those reasons.

Claim 8 further requires that the puree be contained in a food as does claim 14. Lewis et al. disclose that the herb mixture can be mixed with meats and cheeses (col. 4, lines 63-65). Therefore, it would have been obvious to use the claimed puree in foods.

The limitations of claims 10-13 have been discussed above and are obvious for those reasons.

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Claim 16 further requires a particular grain size. However, it is not seen at this time that the disclosed references do not have such a grain size as the products are ground or made into a paste. At any rate it would have been within the skill of the ordinary worker to arrive at such a grain size, as making purees is well known. Therefore, it would have been obvious to grind vegetables to particular grain sizes.

Claim 17 further requires the use of a particular apparatus in a process claim, which is not given weight. Certainly, various apparatuses are known which can grind vegetables, as purees are well known. Therefore, it would have been within the skill of the ordinary worker to choose an apparatus to grind vegetables and it would have been obvious to grind with that apparatus.

Claim 20 further requires at least one salt and claim 21 requires a particular salt. Lewis et al. disclose the use of one salt and claim 21 a particular salt, which is sodium chloride (col. 2, lines 50-64). Therefore, it would have been obvious to use known salts in the claimed composition.

Claim 22 further requires a salt water washing step. However, claim 22 depends on claim 2, which is a composition claim, and no weight is given to the process step of washing with a salt. Therefore, it would have been obvious to make a composition containing salt as disclosed by Lewis et al.

Allowable Subject Matter

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claim15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday 4-10, Wednesday, and Friday, from 9:30 to 6:00 and Tuesday and Thursday 4-10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Hp 1-10-03


HELEN PRATT
PRIMARY EXAMINER